



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,171	07/24/2003	Anil Raj Duggal	130502	8243

6147 7590 06/29/2006

GENERAL ELECTRIC COMPANY
GLOBAL RESEARCH
PATENT DOCKET RM. BLDG. K1-4A59
NISKAYUNA, NY 12309

EXAMINER

EDWARDS, LAURA ESTELLE

ART UNIT	PAPER NUMBER
----------	--------------

1734

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,171

Applicant(s)

DUGGAL ET AL.

Examiner

Laura Edwards

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 17-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 28-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/24/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16 and 28-30, drawn to multiple apparatus, classified in class 118, subclass 500.
- II. Claims 17-27, drawn to multiple processes, classified in class 427, subclass 558.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used for a materially different purposes such as tensioning or stretching fabrics.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Andy Caruso on 3/28/2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-16 and 28-30.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 1734

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

Claims 6, 13, 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, line 1, "said polymer film" lacks antecedent basis.

In claim 13, line 1, "said polymers" lack antecedent basis.

In claim 14, line 1, "said metals" lack antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-11, 13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Scherrer (US 4,104,099).

Art Unit: 1734

Scherrer teaches an apparatus comprising a film (28) and a fixture comprising at least one inner member (10) and at least one outer member (44), the inner and outer members to secure the film therebetween (See Figs. 6 and 7).

With respect to claim 7, the outer member (44) and the inner member form a masking area in the area between which the outer member contacts the inner member. A circular aperture or groove is formed in the inner member as shown in Fig. 7.

With respect to claim 8, another film (32 or 34) can be placed in between the inner and outer members.

With respect to claims 9 and 10, the inner and outer members are edge contoured or rounded to form mating engagement.

With respect to claim 13, the film (28) is made from a thermoplastic, i.e., polyester material.

With respect to claims 15 and 16, another film or liner (32 or 34) can be placed in between the inner and outer members to form a press or friction fit.

Claims 1, 2, 7, 11, 13, and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Freund et al (US 6,142,044).

Freund et al teach an apparatus comprising a thermoplastic film (104/128) and a fixture comprising at least one inner member (114) and at least one outer member (116), the inner and outer members to secure the film therebetween (See Fig. 1).

With respect to claim 7, the outer member (116) and the inner member (114) form a masking area in the area between which the outer member contacts the inner member.

Art Unit: 1734

With respect to claims 28-30, see col. 1, lines 12-24 wherein automated equipment is described.

Claims 1, 7, and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Atteberry et al (US 4,644,639).

Atteberry et al teach an apparatus comprising a commercially available polymeric film (12; col. 3, lines 40-48) and a fixture comprising at least one inner member (16) and at least one outer member (17), the inner and outer members to secure the film therebetween (See Fig. 1).

With respect to claim 7, the outer member (17) and the inner member (16) form a masking area in the area between which the outer member contacts the inner member.

With respect to claims 9 and 10, see Figs. 3-7.

Claims 1, 7-11, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Andrews et al (US 3,633,541).

Andrews et al teach an apparatus comprising a plastic film (col. 1, lines 63-66) and a fixture comprising at least one inner member (11) and at least one outer member (21), the inner and outer members to secure the film therebetween (See Fig. 1).

With respect to claim 7, the outer member (21) and the inner member (11) form a masking area in the area between which the outer member contacts the inner member.

With respect to claim 8, another film or pad (15) can be placed in between the inner and outer members.

Art Unit: 1734

With respect to claims 9 and 10, the inner and outer members are edge contoured or rounded (see the flange at the lower portion of each member) to form mating engagement.

With respect to claims 14, see col. 1, lines 27-30.

With respect to claims 15 and 16, another film or liner (15) can be placed in between the inner and outer members to form a press fit between the inner and outer members.

Claims 1-3, 5-7, and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Rudell et al (US 5,217,222).

Rudell et al teach a toy racket (10) comprising a plastic film (col. 2, lines 39-43) and a fixture having at least one inner member (56) and at least one outer member (46), the inner and outer members to secure the film therebetween (See Figs. 1 and 3).

With respect to claims 5 and 6, the inner and outer members defining the fixture to hold the inner and outer members can be the same as the film and thereby have the same properties. In col. 2, Rudell et al provide the various polymers including polyethylene (col. 2, lines 25-31) and the film can be polyethylene too (col. 2, lines 39-45).

With respect to claim 7, the outer member (46) and the inner member (56) form a masking area in the area between which the outer member contacts the inner member.

With respect to claim 12, the inner and outer members defining the fixture to hold the inner and outer members can be made of different materials such as metal for the outer member (46; col. 3, line 13) and a fiber reinforced material such as cardboard for the inner member (56; col. 3, lines 41-44).

Art Unit: 1734

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scherrer (US 4,104,099).

Scherrer teaches an apparatus as mentioned above and references use of a thermoplastic polymer film (i.e., polyester) but is silent concerning the use of other known thermoplastics (i.e., selected from the group consisting of polybutylene terephthalate; ...2,8-bis(4-hydroxyphenyl)-1-methyl-4-isopropylcyclohexane; and blends of the foregoing polymers. However, it would have been obvious to one of ordinary skill in the art to select a suitable thermoplastic since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Art Unit: 1734

With respect to claims 5 and 6, even though Scherrer is silent concerning the inner and outer members as well as the film being the same material or having the same physical (i.e., thermal) properties, it would have been obvious to one of ordinary skill in the art to make all of the members and film from the same material in the event that the members and film are heat processed to form a single integral element.

Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scherrer (US 4,104,099) in view of Guckel et al (US 5,718,618).

Scherrer teaches an apparatus as mentioned above and references use of an elastomeric o-ring type outer member (44) and an inner member or lapping plate (10). Scherrer is silent concerning the material used to make the lapping plate. However, it was known in the art, at the time the invention was made, to make a conventional lapping plate from metal as evidenced by Guckel et al (see abstract, lines 4-6). It would have been obvious to one of ordinary skill in the art to make the Scherrer lapping plate from metal as taught by Guckel et al since it is conventional in the art to do so. To make the Scherrer lapping plate from a suitable metal is within the purview of one skilled in the art.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudell et al (US 5,217,222).

Rudell et al teach an apparatus as mentioned above and references use of a thermoplastic polymer film (i.e., polyester; col. 2, lines 39-43) but is silent concerning the use of other known thermoplastics (i.e., selected from the group consisting of polybutylene terephthalate;...2,8-

Art Unit: 1734

bis(4-hydroxyphenyl)-1- methyl-4-isopropylcyclohexane; and blends of the foregoing polymers.


However, it would have been obvious to one of ordinary skill in the art to select a suitable thermoplastic since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Laura Edwards
Primary Examiner
Art Unit 1734

Le
June 23, 2006